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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,036	07/07/2004	Alfonso Branca	22990	1492

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EXAMINER

VOGELBACKER, MARK T

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/501,036	Applicant(s) BRANCA, ALFONSO	
	Examiner Mark T. Vogelbacker	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/26/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>FEB 01, 2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Regarding the Applicant's response to the Examiner's proposed Restriction Requirement filed on October 4, 2005, the product and process as claimed does contain unity of invention as a national stage application. Therefore, the Restriction Requirement is hereby withdrawn. Claims 25-44 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 25, 26, 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epel et al., US-4,334,563 in view of Rust et al., US-5,588,343.

Epel discloses the invention as claimed, including a core member (30) consisting of a thermoplastic resin in which a plurality of glass fibers are embedded (col 2, lns 60-62), a second material (32) with highly elastic characteristics (col 3, lns 3-10), and a layer (36) covering the core (30). Epel discloses a combination of chemical and adhesive bonding (col 3, lns 62-64) to form the handle produced by pultrusion (col 4, lns 26-30). Rust teaches a tool handle, produced by pultrusion (col 3, lns 23-39), including two discrete elongated core members (18) extending along the entire length of the element and a bearing (16) of a second material inserted between

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the elongated members (18). Further, Rust teaches a bond between the first and second material without the use of adhesives (col 3, lns 32-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Epel device to include a bond without adhesive, as taught by Rust, to provide an alternative bond between the materials.

Regarding claim 36, the bonding of the first material and the second material is effected by the application of heat in that the thermosetting resin used by Epel requires the appropriate heat to form the material. Therefore, the Office considers that the bonding of the materials is "effected" by heat.

Regarding claims 35-38, the Office considers the method of making the handle device obvious to the structures disclosed by Epel and Rust. Therefore, the method of making the handle is given little patentable weight as claimed.

4. Claim 27, 29-34 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epel et al., US-4,334,563 in view of Rust et al., US-5,588,343, and further in view of Remmert et al., US-5,530,989.

Regarding claims 27, 29, 30 and 39, Epel and Rust disclose the invention as claimed, but do not mention that the second material and layer is an elastomeric polymer or that the second material is a thermoplastic polyurethane. Remmert teaches a tool handle, produced by coextrusion, in which thermoplastic polyurethane is used as a primary material (col 2, ln 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the handle of Epel and Rust to include thermoplastic polyurethane, as taught by Remmert, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design

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choice (*In re Leshin*, 125 USPQ 416). The location of the claimed material is considered obvious to one of ordinary skill in the art at the time the invention was made since it has been held that rearranging parts of an invention involves only routine skill in the art (*In re Japikse*, 86 USPQ 70). Regarding the claimed "elastomeric polymer", polyurethane is known in the art to be an elastomeric polymer.

Regarding claim 39, the Office considers the method of making the handle device obvious to the structures disclosed by Epel, Rust and Remmert. Therefore, the method of making the handle is given little patentable weight as claimed.

5. Claim 28 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epel et al., US-4,334,563 in view of Rust et al., US-5,588,343, in view of Remmert et al., US-5,530,989, and further in view of Edwards, US-6,184,286 B1.

Epel, Rust and Remmert disclose the invention as claimed, but do not mention that the thermoplastic resin is engineered polyurethane thermoplastic polymer (ETPU). Edwards, US-6,184,286 B1 teaches the use of ETPU as an efficient and effective means of dispersing a filler material into a thermoplastic resin. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the handle of Epel, Rust and Remmert to include material comprising ETPU, as taught by Edwards, US-6,184,286 B1, to provide a carrier that is compatible with the target resin, thereby allowing for the efficient dispersion of the filler material in a polymer matrix (col 1, lns 36-39).

Regarding claims 40-43, the Office considers the method of making the handle device obvious to the structures disclosed by Epel, Rust, Remmert and Edwards, US-6,184,286 B1. Therefore, the method of making the handle is given little patentable weight as claimed.

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6. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Epel et al., US-4,334,563 in view of Rust et al., US-5,588,343, in view of Remmert et al., US-5,530,989 in view of Edwards, US-6,184,286 B1 and further in view of Edwards, US-2002/0063349 A1.

Epel, Rust, Remmert and Edwards, US-6,184,286 B1 disclose the invention as claimed, but do not mention the technique of thermoforming to mold the handle. Edwards, US-2002/0063349 A1 teaches the technique of thermoforming to shape pultruded elements (pg 2, [0016], lns 6-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Epel, Rust, Remmert and Edwards, US-6,184,286 B1 to provide a step of thermoforming, as taught by Edwards, US-2002/0063349 A1, to further shape the handle to the desired form.

The Office considers the method of making the handle device obvious to the structures disclosed by Epel, Rust, Remmert, Edwards, US-6,184,286 B1 and Edwards, US-2002/0063349 A1. Therefore, the method of making the handle is given little patentable weight as claimed.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Vogelbacker whose telephone number is (571) 272-1648. The examiner can normally be reached on 8:00 am-5:30 pm Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MTV

Mark Vogelbacker
Assistant Examiner
Art Unit 3677

*See added page 7, attached, as
part of this action.*

Katherine Mitchell
Katherine Mitchell
Primary Examiner

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 25 and 35 recite a material with “predominantly high mechanical characteristics” and “predominantly high elastic characteristics”. How high is “predominantly high”, and how would one of ordinary skill in the art recognize the metes and bounds of these claims? Claims 26-34 and 36-44 are rejected as depending from claims 25 and 35 respectively.

Claim 37 recites “said material” and depends on claim 36, which recites “the first material and the second material”, and which depends on claim 35, which recites “one third material”. Is “said material” of claim 37 the first, second, or third material? Note that this means all claims to the “thermoplastic resin” indefinite -- i.e., claim 38-44. Note in particular that claim 40 thus refers to no specific member.

Re claim 44 -- what defines and ergonomic shape?



Katherine Mitchell
Primary Examiner